

MAY 16 2007

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Part 2 - Remarks

This Second Amendment and Response summarizes telephone conferences between the Examiner and the undersigned, which occurred on April 24, April 26 and May 2. In response to those telephone conferences, claim 63, 70 and 72 have been amended. With these amendments, it is expected that the application is now allowable. In view of the expected allowance of the application, an opportunity to update the reissue declaration, if required, and to submit the original patent are respectfully requested.

Continued and reconsidered examination of the application is therefore requested.

Telephone Conferences

This summary of the telephone conferences on April 24 and 26 and May 2 is intended to constitute a written statement of the issues discussed during those telephone discussions and of the reasons presented as warranting favorable action, as required under 37 CFR 1.133.

The Examiner initiated the telephone conversation on April 24. The Examiner stated that the Response to Second Office Action, filed April 12, 2007, had been considered and that it was persuasive.. However, the Examiner expressed concern about the patentability of claim 63 in view of US patent 5,007,467 to Sterzer. The Examiner asked the undersigned to consider the Sterzer patent.

On April 26, the undersigned called back to discuss the Sterzer patent. It was pointed out that the Sterzer patent used a prostate balloon 122 which is inflated to separate the prostatic urethra from the microwave antenna a sufficient distance to prevent heating that non-prostate tissue beyond a maximum safe temperature. By spacing the non-prostate tissue a greater distance, the variation in respective microwave field intensities is significantly reduced, thereby making it possible to heat the prostate tissue more evenly and to a higher temperature without heating any part of the non-prostate tissue beyond its maximum safe temperature. This is achieved by pumping a liquid through the inflated prostate balloon to act as a coolant for removing

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heat from the non-prostate tissue, thereby maintaining the non-prostate tissue at or below its maximum safe temperature.

It was pointed out that claim 63 uses the capacity of the expandable reservoir containing the heated fluid to heat therapeutically a first region of tissue immediately adjoining the expanded reservoir, with the therapeutic heating capacity being sufficient to enlarge the urine drainage passage. It was noted that the invention of claim 63 appears to be the opposite of Sterzer. Sterzer avoids heating the tissue adjacent the expandable prostate balloon beyond the maximum safe temperature, and that maximum safe temperature would not result in enlargement of the urine drainage passage through the prostate because keeping the temperature below the maximum safe temperature would not result in any tissue changes that could promote enlargement of the urine drainage passage.

The Examiner acknowledged agreement concerning the difference in functionality of Sterzer relative to claim 63, but was concerned about the capacity for therapeutic heating in the context of apparatus claim 63. The Examiner also asked the undersigned to consider the applicability of US patent 5,496,271 to Burton.

On May 2, the undersigned called back to discuss the Burton patent. The undersigned pointed out that the Burton patent disclosed essentially the same functional features as the Sterzer patent, i.e., a coolant circulated through a dilation balloon 18 to protect the surrounding non-diseased tissue, such as the urothelium, against thermal damage by microwave treatment of the prostate. The Examiner acknowledged agreement with this analysis of the Burton patent.

The Examiner stated that he would be favorably inclined to allow apparatus claim 63 if the capacity for thermal heating was described in terms of a capacity for tissue necrosis (death) or tissue coagulation, as described in the specification at column 2, line 28.

In addition, the Examiner acknowledged that claims 75-79 and 81-83 should have been noted as allowed rather than allowable in the January 16, 2007 office action and that claims 70 and 72-74 would be allowable if amended into independent form, as

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stated in the January 16, 2007 office action, apart from any other amendment to claim 63 discussed during the telephone conferences.

Status of Claims

Claims 1-108 are pending.

Claims 1-62 and 84-108 have been allowed.

Claims 75 and 81 were amended into independent form by the Amendment and Response filed on June 12, 2006. Claims 76-79 and 82-83 depend on claims 75 and 81. Claims 75-79 and 81-83 should be allowable and allowed.

Claims 70 and 72-74 were noted as allowable if amended as described in the January 16 office action and in the April and May telephone conversations. Claim 70 has been amended into independent form by incorporating the subject matter of original claim 63. Claims 72 has been amended into independent form by incorporating the subject matter of original claims 63 and 71. Claims 73 and 74 depend on amended claim 72 and should be allowable in conjunction with claim 72. Therefore, claims 70 and 72-74 should also be allowable.

Claims 63-69, 71, 80 and 81

Claim 63 has been amended in the manner set forth to recite that the capacity for therapeutically heating the first and second tissue regions is sufficient to create tissue necrosis which enlarges the urine drainage passage. The amendment is found at lines 25-27 of claim 63 in Part 1 above. In the following reproduction of the relevant phrase, the amendment is shown by underlining:

“the capacity for therapeutically heating the first and second tissue regions being sufficient to cause tissue necrosis in the first and second regions and enlarge the urine drainage passage; and”

This amendment is consistent with the indication of favorable consideration given during the May 2 telephone conference. This amendment patentably distinguishes claim 63 from the Sterzer and Burton patents, because tissue necrosis in the first region appears to be the opposite effect from the tissue-preservation and damage-prevention

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effects described in Sterzer and Burton. Accordingly, it is believed that claim 63 and its dependent claims 64-69, 71, 80 and 81 should now be allowable.

Claim 70

Claim 70 has been amended by combining original claim 63 and original claim 70.

Claims 72-74

Original claim 72 depended on original claim 71, and original claim 71 depended on original claim 63. Amended claim 72 has been formulated by combining original claims 71 and 73. The following phrase in original claim 71:

a tissue temperature sensor connected to the catheter to sense the temperature of the tissue surrounding the reservoir,  
and the following original phrase in claim 72:

the tissue temperature sensor is connected to the carrier at a position which measures the temperature of the prostate at distance away from the expandable reservoir,

have been integrated into the following single phrase in amended claims 72:

a tissue temperature sensor connected to the carrier to sense the temperature of the prostate tissue surrounding the reservoir at distance away from the expandable reservoir.

It is believed that this integration contains all of the subject matter previously recited in the two separate phrases.

Claims 73 and 74 depend on amended claims 72, and should be allowable in conjunction with amended claims 72.

Updated Reissue Declaration and Original Patent

If the pending claims are found allowable, as expected, and if an updated reissue declaration is considered necessary, an opportunity to do so is respectfully requested. In addition, an opportunity to surrender the original patent, as offered, is also respectfully requested.

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Conclusion

For the reasons explained and others, it is believed that all pending claims are in condition for allowance. Allowance is respectfully requested. The Examiner is requested to contact the undersigned by telephone to discuss any issues which may inhibit the immediate allowance of the claims.

The fees for the claim amendments, as shown on the attached transmittal letter, may be charged to the deposit account 12-1087 of the undersigned.

Respectfully submitted,

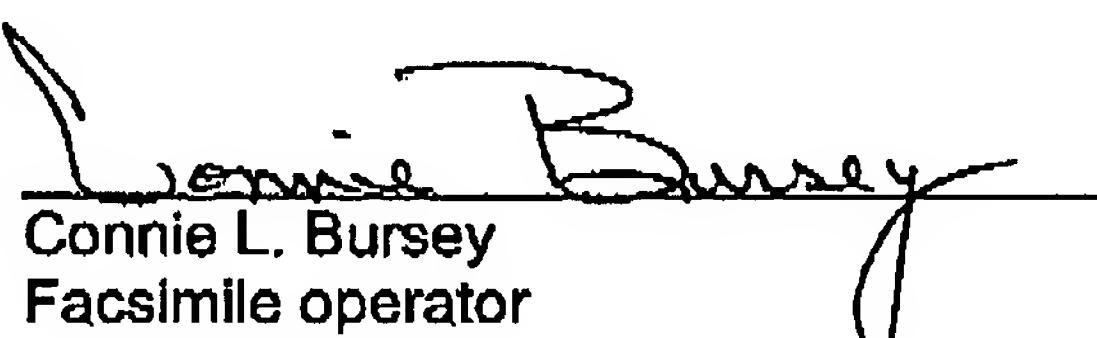
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Certificate of Filing by Facsimile Transmission

The undersigned hereby certifies that the foregoing **Second Amendment and Response**, and the attached transmittal letter, are being transmitted by facsimile to the United States Patent and Trademark Office, at the Central PTO facsimile number 571 273 8300, this 16<sup>th</sup> day of May, 2007.



Connie L. Bursey  
Facsimile operator